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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,284	07/12/2002	Kenshu Shimada	09812.0438	3062
22852	7590	08/09/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			HAQ, NAEEM U	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/070,284

Applicant(s)

SHIMADA, KENSHU

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-55 is/are pending in the application.
- 4a) Of the above claim(s) 5, 7, 10, 13 and 15-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 8, 9, 11, 12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/5/02; 1/17/06</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicant's amendment filed May 30, 2006.

Claim 2 has been cancelled. Claims 1 and 3-55 are pending. Claims 5, 7, 10, 13, and 15-55 were withdrawn in a previous Office Action and remain withdrawn. Claims 1, 3, 4, 6, 8, 9, 11, 12, and 14 will be considered for examination.

### ***Specification***

The amendment filed May 30, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claim 1 recites the limitation "candidate determining means for..." There is no support for this limitation in the Applicant's specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1, 3, 4, 6, 8, 9, 11, 12, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites the limitation "candidate determining means for..." There is no support for this limitation in the Applicant's specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 4, 6, 8, 9, 11, 12, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The words "candidate" and "order candidate" in claim 1 are relative words, which renders the claim indefinite. The words "candidate" and "order candidate" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes, the words "candidate" and "order candidate" were treated as the product(s) being ordered by the customer. Furthermore, claim 1 recites the limitation "candidate determining means for..." It is unclear to the Examiner what structure the Applicant is attempting to claim by using the means plus function language because there is no support for this limitation in the Applicant's specification. For examination

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purposes, the Examiner will assume that the limitation “candidate determining means for...” refers to software. Finally, claim 1 is directed to an “apparatus”, however, this claim has no physical structure as per the analysis given below in the rejection under 35 U.S.C. 101. Therefore, it is unclear the Examiner how a series of programs can constitute an “apparatus”. The dependent claims are rejected under a similar rationale.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3, 4, 6, 8, 9, 11, 12, and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is directed to an “apparatus”. This “apparatus” has four components: (1) an order information acquisition means, (2) a candidate determining means, (3) a related commodity information transmission means, and (4) a commodity shipping command means. The Applicant’s specification discloses that the “order information acquisition means” is a program (see page 17, line 14 – page 18, line 2). The specification also discloses that the “related commodity information transmission means” and the “commodity shipping command means” are programs (see page 29, lines 15-20; page 18, lines 3-5; page 26, lines 2-4). Thus, the “apparatus” of claim 1 comprises a series of programs. The Examiner notes that a program is not a physical structure, and therefore the “apparatus” of claim 1 has no physical structure. For this reason, claim 1 is deemed to be non-statutory subject matter. The dependent claims 3,

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4, 6, 8, 9, 11, 12, and 14 do not correct this problem and are rejected under same rationale.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 3, 6, 8, 9, 12, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson (US 6,167,383).**

Referring to claim 1: Henson teaches a commodity selling apparatus for accepting an order of a commodity responsive to a request by a customer to purchase the commodity over a network and for directly shipping the ordered commodity to said customer, comprising:

- order information acquisition means for acquiring the order information, prepared on accepting the request to purchase the commodity from the customer, over said network and commodity shipping command means for commanding the shipping of the commodity ordered to said customer based on said order information acquired by said order information acquisition means (see at least Abstract, col. 1, lines 60 – 63; col. 3, lines 31 - 32 and Figures 1 , 2 and 3C);
- candidate determining means for determining an order candidate including a list of one or more related commodities determined to be connectable to the commodity based on related commodity information associated with the commodity (col. 9, lines 56-60; col. 10, lines 7-15). The Applicant's specification

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discloses that term "related commodity" is a commodity "...*that can be connected to a specified commodity by at least one of the direct connection, wireless connection, removable connection, internal mounting and indirect loading.*" (see specification page 57, lines 7-10). Henson teaches recommending an add-on, upgrade, or a cross-sell based on the contents of the shopping cart. These add-ons and upgrades can be hardware or software that require a direct connection and/or loading.

- related commodity information transmission means for transmitting the order candidate over said network and wherein the order information acquisition means acquires the order information over the network following transmission of the order candidate by the related commodity information transmission means (Abstract and Figures 1, 2 and col. 3, lines 45 - 54);

For Examination purposes, "sales store" was treated as equivalent to separate virtual stores for each customer (see col. 14, lines 35 - 61). Finally as noted above, the use of these words/phrase maybe a result of translation, which hampers the determining the metes and bounds of the claims.

Referring to claim 3: Henson teaches a commodity selling apparatus wherein said related commodity information transmission means includes delivery term presenting means for presenting the term of delivery of the commodity and the quantity of possible orders under said term of delivery, in a confirmable form, responsive to a request from a sale store, to said sale store over said network; said order information acquisition means acquiring, from said sale store, the order information prepared on accepting the request to purchase the commodity from the customer in accordance with

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a delivery term presented by said delivery term presenting means, over said network; said commodity shipping command means commanding the shipping to said customer of the commodity booked on the basis of the order information acquired by said order information acquisition means, within the term of delivery presented by said delivery term presenting means (col. 7, lines 1 - 21 and Figure 9).

Referring to claim 6: Henson teaches a commodity selling apparatus wherein said order information acquisition means acquiring the information specifying a commodity as the order information and the information pertinent to the shipping destination of said commodity; said commodity shipping command means transmitting the information pertinent to the shipping destination of said commodity along with a command for shipping the booked community (Figure 9).

Referring to claim 8: Henson teaches a commodity selling apparatus wherein said related commodity information transmission means including delivery term presenting means for presenting the term of delivery of a commodity and the quantity of possible orders under said delivery term in a confirmable form to a booking terminal connected over a network to said related commodity information transmission means responsive to a request from said booking terminal (Figure 9);

said order information acquisition means acquiring from said booking terminal the order information formulated on the basis of the request by a customer to purchase a commodity under a term of delivery presented by said delivery term presenting means (Figure 9);



said commodity shipping command means commanding the shipping of the booked commodity to said customer within the term of delivery presented by said delivery term presenting means, based on the order information acquired by said order information acquisition means (Abstract and Figure 9).

Referring to claim 9: Henson teaches a commodity selling apparatus according wherein said commodity is formed by a plurality of individual commodities (Figure 3A); said related commodity information transmission means including delivery term presenting means for presenting, responsive to a request from a sale store, the term of delivery of said individual commodities and the quantity of possible orders under said delivery term in a confirmable form to said sale store (Figure 9); said order information acquisition means acquiring from said sale store the order information formulated on the basis of the request from a customer to purchase the commodity under the term of delivery presented by said delivery term presenting means (Abstract and Figure 9); said commodity shipping command means commanding the booked commodity to be shipped to said customer within the term of delivery presented by said delivery term presenting means on the basis of the order information acquired by said order information acquisition means (Figure 9).

Referring to claim 12: Henson teaches a commodity selling apparatus according wherein said order information acquisition means acquires the information specifying the individual commodity forming a commodity as the order information and the information pertinent to the shipping destination of said commodity; said commodity shipping command means transmitting the information pertinent to the shipping

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destination of said commodity along with a shipping command for the booked commodity (Figure 9).

Referring to claim 14: Henson teaches a commodity selling apparatus wherein said commodity is formed by a plurality of individual commodities; said related commodity information transmission means including delivery term presenting means for presenting, responsive to a request from a booking terminal connected over a network, the term of delivery of said individual commodities and the quantity of possible orders under said delivery term, in a confirmable form to said sale store; said order information acquisition means acquiring from said booking terminal the order information formulated on the basis of the request accepted from a customer to purchase the commodity under the term of delivery presented by said delivery term presenting means; said commodity shipment command means commanding the booked commodity to be shipped to said customer within the term of delivery presented by said delivery term presenting means on the basis of the order information acquired by said order information acquisition means (Figure 3A and Figure 9).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of Bellini (US 5,974,395).**

Henson substantially discloses and teaches the Applicant's invention. Henson does not specially disclose and teach a commodity selling apparatus further comprising: production quantity acquisition means for acquiring the total production quantity per preset period of time of respective commodities, produced in accordance with a production schedule drafted under a preset production schedule sequence; said delivery term presenting means presenting the delivery term as said preset period of time, with an unbooked fraction of the total production quantity during said preset time period as the quantity of possible orders. However, Bellini teaches a commodity selling apparatus further comprising: production quantity acquisition means for acquiring the total production quantity per preset period of time of respective commodities, produced in accordance with a production schedule drafted under a preset production schedule sequence; said delivery term presenting means presenting the delivery term as said preset period of time, with an unbooked fraction of the total production quantity during said preset time period as the quantity of possible orders (Abstract; col. 2, lines 55 – 67; col. 3, lines 9 – 15; col. 5, lines 36 – 59; and Figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Bellini into the apparatus of Henson. One of ordinary skill in the art would

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have been motivated to do so in order ensure the timely production and delivery of products.

**Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of Kennedy (US 6,188,989 B1).**

Henson substantially discloses and teaches the Applicant's invention. Henson does not specifically disclose and teach a commodity selling apparatus according further comprising: production quantity acquisition means for acquiring the total production quantity per preset time period for each individual commodity produced in accordance with a production schedule drafted under a preset production schedule sequence; and sale quantity allocation means for deciding an allocation quantity to each sale store corresponding to a fraction of the total production quantity per preset time period as obtained by said production quantity acquisition means; said delivery term presenting means presenting said preset time period as the term of delivery, with an unbooked fraction of said allocation quantity to the sale store which has made said purchase request, as the quantity of possible orders during said preset time period, in a confirmable form to said sale store. However, Kennedy teaches a commodity selling apparatus according further comprising: production quantity acquisition means for acquiring the total production quantity per preset time period for each individual commodity produced in accordance with a production schedule drafted under a preset production schedule sequence', and sale quantity allocation means for deciding an allocation quantity to each sale store corresponding to a fraction of the total production quantity per preset time period as obtained by said production quantity acquisition

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means; said delivery term presenting means presenting said preset time period as the term of delivery, with an unbooked fraction of said allocation quantity to the sale store which has made said purchase request, as the quantity of possible orders during said preset time period, in a confirmable form to said sale store (Abstract, col. 2, lines 37-45; col. 3, lines 35-41; col. 15, lines 38 - 46). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Kennedy into the apparatus of Henson. One of ordinary skill in the art would have been motivated to do so in order ensure the timely production and delivery of products.

### ***Response to Arguments***

Applicant's arguments filed May 30, 2006 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Naeem Haq', with a stylized, flowing script.

**Naeem Haq**, Primary Examiner  
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August 4, 2006